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08/865,419 05/28/97 AUGER

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EXAMINER

LIOTT, C

ART UNIT

PAPER NUMBER

1751

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DATE MAILED:

07/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/865,419

Applicant(s)

Auger

Examiner

Caroline D. Liott

Group Art Unit

1751



☒ Responsive to communication(s) filed on Apr 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10, 20-23, 25, 26, and 29-36 is/are pending in the application.

Of the above, claim(s) 23, 25, 26, and 29 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10, 20-22, and 30-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-10, 20-23, 25, 26, and 29-36 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The request filed on 4/29/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/865,419 is acceptable and a CPA has been established. An action on the CPA follows.

Applicant's Amendments filed 4/29/99 have been entered. Claims 11-19, 24, 27 and 28 have been canceled accordingly. Applicant's Remarks filed 4/29/99 have been fully considered.

Restriction Requirement

The restriction requirement remains for the reasons as set forth in the prior application. Prosecution is being continued on the invention elected in the prior application, i.e. Group I, which reads on instant claims 1, 3-10, 30 and 32-36. Previously non-elected method claims 2 and 20-22 have also been examined with this Office Action. Claims 23, 25-26 and 29 stand drawn to an invention nonelected with traverse in Paper No. 11.

Claim Objections

Claim 2 and 20-22 are objected to because of the following informalities:

Claims 2 and 20-22 should recite "A method for treating and coloring a wood substrate."

Applicant is also suggested to simply claim a "A method for coloring a wood substrate."

In line 4 of claim 2, the term --the-- should be inserted before the term "first."

In part (c) of claim 2, the term "preparation" should read "preparations."

In part (d) of claim 2, the term "color characteristics of" should be deleted.

The term "applying" should be inserted after the term "comprising" in claim 22.

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Two commas follow the term “thickener” in line 4 of claim 31. Appropriate correction is required.

Applicant is suggested to recite kits “for coloring a wood substrate” in claims 1 and 30.

Applicant is also suggested to insert the term “thereof” after the term “combinations” in claims 4-8 and 10.

Claim Rejections

Claims 1-10, 20-22, 30 and 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 30 are indefinite because the term “metal/mineral salt” is defined so broadly that it reads on the claimed “oxygen source” and/or “peroxide.” For example, zinc peroxide reads on both the claimed salts and oxygen sources, see claims 8 and 10. This causes confusion in the claims, e.g. can a single aqueous solution of zinc peroxide read on the claimed kits?

Similarly, the “base” of claim 31 reads on the “oxygen source” of claim 30 (e.g. sodium hydroxide). A claim is indefinite when two terms are defined so broadly that they read upon one another. Clarification is required.

Claim 1 is indefinite for reciting a kit, and for also reciting method steps in the claim, i.e. “the mineral salt and peroxide solutions *applied* sequentially in effective amounts to the substrate, and *reacting* with each other in the presence of the substrate to impart the color to the substrate.” This causes confusion as to whether or not a kit or method is being defined by the claims. Note

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that a claim can only be drawn to one statutory class of invention. Clarification is required. This claim has been examined as a kit requiring no method steps.

Claim 3 is indefinite for reciting that both preparations are “exclusively” aqueous solutions because it is unclear what this term means. Are all other components excluded from the claimed solutions? If so, conventional “consisting essentially of” language should be used. Clarification is required.

Claim 7 is indefinite because the salt “silver sulfate” is listed twice.

Claim 8 is indefinite because “zinc powder” is not a metal salt. This term should be deleted from the Markush group.

Claim 21 is indefinite because the term “the process conditions of the method” lacks proper antecedent basis in the claims.

Claim 22 is indefinite because the term “the substrate surface” lacks proper antecedent basis in the claims.

Claim 30 is indefinite for reciting that the preparations further comprise an “aqueous” additive. The claimed preparations are aqueous, and it is unclear if the claimed additives must be added as aqueous solutions or are simply aqueous because the preparations are aqueous. Clarification is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsushita Electric Works.

Matsushita Electric Works, JP 60-250,906, teaches and exemplifies a two-component “kit” for imparting a pre-determined bleached color to a wood substrate which comprises an aqueous solution consisting of a cobalt or nickel metal salt, and an aqueous solution consisting of hydrogen peroxide, see page 4, Table and paragraph 1. Matsushita Electric Works, therefore, clearly anticipates kits as claimed. Note that Matsushita’s bleaching kits do not anticipate or obviate “kits for coloring wood substrates” as claimed because bleaching is the opposite of coloring; however, bleaching does result in a “pre-determined color” as currently claimed.

Claims 3-7, 9-10 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown.

Brown, U.S. Patent No. 5,173,085, teaches and exemplifies three-part compositions for dyeing hair wherein the first part comprises an aqueous solution which contains additives (e.g. a surfactant) and a metal salt (e.g. copper sulfate) in the claimed amounts, and the third part

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comprises a 6% aqueous solution of hydrogen peroxide, see Examples 2-4. Brown, therefore, clearly anticipates the claimed kits.

Claims 3-10 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Tennigkeit.

Tennigkeit, U.S. Patent No. 4,992,077, teaches and exemplifies two-part compositions for dyeing hair wherein the first part comprises water, additives and a metal salt (copper (II) chloride or copper sulfate) in the claimed amounts, and the second part contains hydrogen peroxide in the claimed amounts, see Examples 1a-3a and col. 5, lines 22-27. Tennigkeit, therefore, clearly anticipates kits as claimed.

Claims 1, 3-6, 9-10, 30 and 32-36 are rejected under 35 U.S.C. 102(b) as anticipated by Est. Light Ind. Min (herein referred to as Light).

Light, SU 499,297 (see English language translation for all citations), teaches processes for treating leather by first treating with a solution which contains hydrogen peroxide and sodium hydroxide (oxygen sources and base) in the claimed amounts, followed by treating with a solution which contains alum (aluminum potassium sulfate) alone or in combination with chromium salts in the claimed amounts, see Example. Light, therefore, clearly anticipates kits as claimed.

Claims 3-7, 30-31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Yantai University.

Yantai University, CN 86-104,010, teaches and exemplifies two compositions which are applied stepwise to marble to impart a color to the marble, wherein the first part is a solution of

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silver nitrate, and the second part is a solution of water, formaldehyde and sodium hydroxide (oxygen source) as claimed, see provided CAPLUS Abstract. Yantai University, therefore, clearly anticipates kits as claimed.

Claims 2-10, 21, 30-31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Bures.

Bures, CS 145,495 (see provide CAPLUS Abstract for all citations) teaches and exemplifies a three step process for treating wood with three aqueous solutions wherein the first solution (A) contains the claimed manganese chloride, ferric chloride, alcohol and hydrogen peroxide, and the third solution (C) contains the claimed silver nitrate. The solutions appear to be applied at room temperature. Bures, therefore, anticipates kits and methods as claimed.

Claims 2-8, 9-10, 20-22, 30-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Dombay.

Dombay, U.S. Patent No. 3,554,785, teaches and exemplifies a process for treating wood (teak) with a kit as claimed in order to obtain a color on the wood, see Example 4. Specifically, the "kit" comprises a solution A which contains the metal salt cupric sulfate in the claimed amounts, as well as an acid (hydrochloric) as claimed, see Example 4. This composition is diluted with water and is first applied to the wood, followed by drying as claimed. The wood is then treated with a second aqueous solution which contains hydrogen peroxide in the claimed amounts, see Example 4 and col. 3, lines 19-25. Dombay teaches that this solution is also suitable for

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dilution as claimed, see col. 5, lines 56-64. The wood is then treated with a nitrocellulose lacquer (sealant) as claimed. The method takes place at room temperature.

Also note Example 5 wherein wood is treated with a first composition containing potassium permanganate in the claimed amounts, and additives as claimed, wherein the composition is diluted with water as claimed. After drying and treating with a hypochlorite composition, the wood is treated with a solution of hydrogen peroxide as claimed. Dombay, therefore, clearly anticipates wood coloring kits as claimed, and wood coloring methods as claimed.

Claims 2-8, 9-10, 20-22 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dombay.

Dombay is relied upon as set forth above as teaching and exemplifying wood coloring kits which comprise an aqueous solution of a metal salt, and an aqueous solution of hydrogen peroxide as claimed. Dombay teaches that the peroxide oxidant may be present in the lower claimed proportions (see col. 4, lines 35-38), but does not exemplify a kit which contains the peroxide in such proportions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a kit which comprises a first composition which contains water and a metal salt in the claimed amounts, and a second composition which contains water and hydrogen peroxide in the claimed amounts, wherein each composition is sequentially applied to wood to color the wood, because such kits fall within the scope of those as taught by Dombay.

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Response to Arguments

After reconsideration of the prior art and Applicant's Remarks and Amendments, the previous rejections over Zemans, Gentile and Hall have been withdrawn. These references do not teach kits for coloring substrates (wood) which comprise metal salt solutions and oxygen source solutions as claimed.

Regarding the rejections over Dombay, Applicant argues that Dombay has nothing to do with the claimed invention. Examiner disagrees because Dombay successively treats wood with aqueous metal salt preparations and hydrogen peroxide preparations to obtain a color as claimed. Dombay's other additives are not excluded from the claimed kits and methods. Therefore, the rejection over Dombay remains.

Regarding the above rejection over Brown, Applicant argues that Brown dyes hair, not wood. It is well settled that a mere statement of a new use for an otherwise old or mere obvious composition cannot render a claim to the composition patentable. See *In re Zierden*, 162 USPQ 102, 107. The intended use of the claimed kits is given little, if any, patentable weight. See *In re Albertson*, 141 USPQ 730 (CCPA 1964), and *In re Heck*, 114 USPQ 161 (CCPA 1957).

Applicant argues that Brown's methods comprise intermediate steps, and that Brown's peroxide bleaches rather than fixing the metal salts. The claimed kits do not exclude Brown's intermediate steps/solutions, and the intended use of the claimed components is also not given patentable weight. Therefore, the rejection over Brown remains.

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Regarding Light, Applicant again argues that Light treats leather rather than wood. This argument is not deemed persuasive for the reasons explained above. For all these reasons, the above rejections remain.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note particularly the cited Ube Industries Abstracts, JP 8-259,356; JP 8-259,355; JP 8-259,357; JP 7-247,186; and JP 7-242,475. These references are particularly relevant to the claimed kits because they teach two-component solutions for coloring concrete wherein the first component contains a metal salt as claimed, and the second component contains an oxygen source as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. All official before final faxes should be sent to (703)305-7718. All official after final faxes should be sent to (703)305-3599. All non-official faxes should be sent to (703)305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.


CAROLINE D. LIOTT
PRIMARY EXAMINER

C.D.L.
July 19, 1999